

Application No. 09/934310
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Amendment
Attorney Docket No. S63.2N-8429-US04

Remarks

Claims 34 – 41 are pending in this application. By this Amendment, claims 34 and 39 are amended, claims 42 – 46 are added and claims 36 and 41 are cancelled without prejudice or disclaimer. Claims 34 and 39, and the specification are amended to obviate the Office Action's objections. No new matter has been added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Information Disclosure Statement

The Examiner has alleged that the IDS filed August 21, 2001 fails to comply with 37 CFR 1.98(a)(2), and that because copies of the cited patent applications were not provided, they have been struck through without consideration.

Although copies of the cited applications were not required under 37 CFR 1.98(d) because the information was previously submitted to the Office in an application from which priority of the instant application is claimed, which is properly identified in the IDS and is relied upon for an earlier filing date, applicant submits copies of the appropriate applications as a courtesy.

The Examiner has also noted that one page of form PTO-1449 was not considered because it was not legible. Applicant notes that the page that the Examiner considered illegible was a copy of the Examiner's form PTO-892 from Application No. 08/845,734, which is an application from which priority of the instant application is claimed. In accordance with the MPEP, the references are presumed to have been considered. Applicant submits herewith a legible form PTO-1449 containing information transcribed from the original form PTO-892 as a courtesy.

Specification

The Office Action objects to the specification. By this Amendment, the specification is amended to obviate the objections. Specifically, on page 1, the continuing data has been updated and a minor grammatical error has been corrected. On pages 7 and 8, the Brief Description of the Drawings section has been updated. The abstract has been updated.

Accordingly, Applicant respectfully requests withdrawal of the objections to the

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specification.

Claim Rejections - 35 USC § 112

The Office Action rejects claims 34 – 41 under 35 USC § 112, first paragraph and 35 USC § 112, second paragraph. Independent claims 34 and 39 are amended for clarification purposes.

Accordingly, Applicants request withdrawal of the rejections under 35 USC § 112, first and second paragraphs.

Double Patenting

The Office Action rejects claims of the present application under the judicially created doctrine of obviousness type double patenting over claims in US Patents 5,922,021, 5,954,743 and 6,152,957. In furtherance of prosecution, a Terminal Disclaimer is enclosed herewith that disclaims the terminal part of any patent granted on the instant application which would extend beyond the expiration date of the cited patents. Accordingly, Applicant respectfully requests withdrawal of the double patenting rejections.

Claim Rejections

The Office Action rejects, under 35 USC § 102, claims 34 – 37 over Pinchuk (US 5,575,818), claims 34 – 41 over Hankh et al. (US 5,922,019, hereinafter "Hankh") and claims 34 – 41 over Porter (US 5,064,435).

Applicant asserts that neither Pinchuk, Hankh nor Porter disclose or suggest a stent formed from a tube, as recited in independent claim 34 and similarly recited in independent claim 39. Support for these claims may be found in the specification at least at page 25, lines 17 – 23.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Pinchuk, Hankh and Porter all disclose braided or woven wire stents (see Pinchuk column 4, lines 54 – 56; Hankh column 2, lines 39 – 47; and Porter column 3, lines 3 – 6). By definition, a braided or woven wire stent is not formed from a tube of material.

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Therefore, Applicant respectfully submits that independent claims 34 and 39 define patentable subject matter. Claims 35, 37 and 38 depend from independent claim 34, and claim 40 depends from independent claim 39. As such, claims 35, 37, 38 and 40 also define patentable subject matter. Accordingly, Applicant respectfully requests the withdrawal of the rejections under 35 USC § 102.

Formalities

If an extension of time is required to make this response timely and no separate petition is enclosed, Applicant hereby petitions for an extension of time sufficient to make the response timely. In the event that this response requires the payment of government fees and payment is not enclosed, please charge Deposit Account No. 22-0350.

Conclusion

Based on at least the foregoing amendments and remarks, Applicant respectfully submits this application is in condition for allowance. Favorable consideration and prompt allowance of claims 34, 35, 37 – 40, and 42 – 46 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: July 8, 2003

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